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PETITION under 37 C.F.R. 1.181	Attorney Docket No.	SEEK-001CON
	Confirmation No.	7039
	First Named Inventor	Ellen L. Berg
	Application Number	10/716,349
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	Group Art Unit	1631
	Examiner Name	Karlheinz Skowronek
Title: <i>Function Homology Screening</i>		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request the Commissioner to review the restriction requirement in the above-captioned patent application.

The Office Action of January 22, 2008 states that previously submitted Claim 23 is directed to an invention that is independent or distinct from the invention originally claimed. It is further stated the invention of Claim 23 has different steps and produces a materially different effect from the invention of Claims 17-22.

Specifically the Office Action asserts:

Applicant's election with traverse of the invention of claims 17 and 19-22 in the reply filed on 26 October 2007 is acknowledged. The traversal is on the ground(s) that both methods relate to a process wherein cells are contacted with an agent and changes are recorded to a biomap or a biological data set profile. This is not found persuasive because the methods have distinct steps the results of which distinguish a biomap from a biological data set profile. For example, claim 17 characterizes a biological data set profile that is limited to recorded measurements from test and control cell. The biomap of claim 23 is distinguished from the data set profile of claim 17 by requiring the recorded measurements to be further manipulated to produce normalized ratios from optimized parameter readouts. The method of claim 23 is further distinguished from the method of claim 17 via an additional analysis step using a multi-parameter pattern recognition algorithm. Thus claim 17, directed to method of

measuring and recording parameters in response to an agent is distinct from the method of claim 23, directed to a method of characterizing an agent by comparison of biomaps.

Applicants respectfully request rejoinder of Claims 17, 19-22 and 23, and submit that the claims are drawn to a common invention, where a candidate compound is analyzed for a biological activity of interest (Claim 17) or characterized according to its biological activity (Claim 23). Both claims relate to a process wherein a candidate agent is contacted with cells in culture stimulated by a "plurality", or "by at least two", factors.

The methods of both Claims 17 and 23 record changes in cellular parameters to generate a "biomap", or "biological data set profile". The specification teaches that a dataset as used in Claim 23, and biomap are terms used interchangeably, e.g. in the specification at paragraph 44, paragraph 46, paragraph 48, paragraph 51, paragraph 83, etc.

Thus, the difference between Claim 17 and Claim 23 is that Claim 23 recites additional analysis of the information obtained from recording changes in cellular parameters, thus making Claim 23 a subset within the generic invention described in Claim 17.

Applicants further note that co-pending patent filings by Applicants have been amended during prosecution to contain claim language similar to that of Claim 23, for example recently issued U.S. Patent no. 7,266,458 recites:

1. *A method for characterization of a genetic agent according to its mechanism of action on cellular signaling pathways, the method comprising:*

expressing said genetic agent in a cell, wherein said cell is present in a cell culture assay combination, wherein said cell culture assay combination comprises cells and at least two factors sufficient to provide a physiological state of interest involving at least two pathways;

recording changes in at least two different cellular parameter readouts whose levels vary as a result of introduction of said genetic agent;

deriving a biomap dataset from said parameter readouts wherein said biomap comprises data normalized to be a ratio of test to control data on the same cell type under control conditions in the absence of said genetic agent, and said parameters are optimized so that the set of data in the biomap is sufficiently informative that it can discriminate the mechanism of action of said agent; and

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analyzing said biomap by a multiparameter pattern recognition algorithm to quantify relatedness of said biomap to reference biomaps that include known genetic agents that target specific pathways, wherein the presence or absence of relatedness to said reference biomaps provides a characterization of said genetic agent mechanism of action.

In view of the above remarks, rejoinder is requested.

Therefore, in view of the above, the Applicants respectfully request a review of the Restriction Requirement and rejoinder of Claims 17-22 and 23.

The Commissioner is hereby authorized to charge any other fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number SEEK-001CON.

Respectfully submitted,
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